IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hsi-Hsun Huang

Application No.: 09/828,856	Confirmation No.: 6956
Filed: April 10, 2001	Art Unit: 2625
For: **NETWORK SERVER FOR PROVIDING SCANNING FUNCTIONALITY TO A COMPUTER**	Examiner: Q. N. Vo

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on August 25, 2010, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

INTRODUCTION–TABLE OF CONTENTS

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2. The complete Table of Contents follows.

I.   REAL PARTY IN INTEREST

The real party in interest for this appeal is Transpacific Optics, LLC.

II.   RELATED APPEALS AND INTERFERENCES

Neither Appellant, Appellant's legal representative, nor the above-identified Assignee are aware of other appeals or interferences that are related to, will directly affect or be directly affected by, or have a bearing on the Board's decision in the present appeal.

III.   STATUS OF CLAIMS

A.   Total Number of Claims in Application

There are 34 claims pending in application. The text of these claims is set forth below in the Claims Appendix.

B.   Current Status of Claims

1. Claims pending: 3-8, 10, 11, 13-16, 18-25, 28, 30, 32-35, 37-40, 42-45

2. Claims allowed: None

3. Claims rejected: 3-8, 10, 11, 13-16, 18-25, 28, 30, 32-35, 37-40, 42-45

4. Claims canceled: 1-2, 9, 12, 17, 26-27, 29, 31, 36, 41

5. Claims withdrawn: None

C.   Claims On Appeal

The claims on appeal are claims 3-8, 10, 11, 13-16, 18-25, 28, 30, 32-35, 27-40, and 42-45.

IV.   STATUS OF AMENDMENTS

Appellant did not file an Amendment in response to the Final Office Action (the "Final Office Action") dated May 25, 2010. Appellant filed an Amendment on March 1, 2010 in response to a Non-Final Office Action mailed October 27, 2010. However, the Examiner seemingly erred by basing his rejections in the Final Office Action on the claims *without* the March 1, 2010 Amendment. In an effort to expedite this proceeding, Appellant's arguments below are based on the claims as amended in the March 1, 2010 Amendment.

Accordingly, the claims set forth below in the Claims Appendix do incorporate the amendments to claims 3-8, 10, 11, 13-16, 18-25, 28, 30, 32-35, 27-40, 42-45 as indicated in the Amendment filed March 1, 2010.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

A.   Overview of Appellant's Technology

Appellant's technology is directed generally to a network server that allows a user to connect with a plurality of scanners without requiring pre-installed scanner driver software. (Specification at 3:10-14.) The server includes a database of scanner drivers and a driver selection system that enables the user to select a driver for a desired scanner from the database of scanner drivers. (Specification at 2:27-29.) The server also includes a destination selection system that enables the user to choose a location where scanning data should be sent after a scan and generates a destination address corresponding to the selected location. (Specification at 7:26-32.) The server further includes a delivery system that transfers the selected driver and the selected destination address in a self-extractable executable file to the user's computer and executes the driver.   The driver uses the scanner to scan a document, and scanning data corresponding to the document is saved to the selected location. (Specification at 8:16-18 and 8:29-32.)

B.   Independent Claims on Appeal

Each independent claim being appealed is paraphrased below with citations to corresponding portions of the Specification and drawings as required by 37 C.F.R. § 41.37(c)(1)(v). These citations are provided to illustrate specific examples and embodiments of the recited claim language, and are not intended to limit the claims.

1.   Independent Claim 25

Independent claim 25 is directed to a server for a network that is configured to enable a user at a computer to scan a document at a scanner and obtain scanning data. (Specification at 2:14-23, 3:4-6, 8:31-9:2, and Figures 1 and 2.) The server comprises a database of scanner drivers and a driver selection system. (Specification at 2:27, 6:7-8, 6:15-29, and Figure 2.) The driver selection system is configured to enable the user to select a driver for the scanner from the database of scanner drivers in response to one or more inputs provided to a browser hosted at the computer. (Specification at 2:25-30, 6:11-15, 6:29-32, and Figure 4.) The browser enables the user to browse information received over a data transmission network. (Specification at 2:25-26, 3:13-20, and Figures 1-5.) The one or more inputs are received at the server over the data transmission network. (Specification at 7:22-26, and Figures 1 and 2.) The server further comprises a destination selection system configured to enable the user to select a location from the browser for saving the scanning data. (Specification at 7:1-20, 7:30-33, and Figures 2 and 4.) The location is selected from locations including locations other than the computer. (Specification at 3:16-19, 7:13-20, and Figure 4.) The destination selection system also inserts a destination address of the selected location for saving the scanning data in a self-extracting executable file. (Specification at 8:16-26, 9:1-5, and Figure 2.) The self-extracting executable file also includes the selected driver. (Specification at 8:16-23, and Figure 2.) The server is configured to transfer the self-extracting executable file, including the selected driver and the selected location for saving the scanning data, to the computer. (Specification at 2:30-33, 8:26-31, and Figures 1 and 2.)

2.   <u>Independent Claim 28</u>

Independent claim 28 is directed to a system comprising a scanning station and a server. (Specification at 4:13-15, and Figures 1 and 2.) The scanning station comprises a computer connected to a data transmission network and a scanner in communication with the computer. (Specification at 4:15-31, and Figures 1 and 2.) The computer includes a browser that enables a user to browse information received over the data transmission network. (Specification at 2:25-26, 3:13-20, 5:3-7, and Figures 2-5.) The server comprises a plurality of scanner drivers and a driver selection system to select one of the plurality of scanner drivers in response to one or more inputs provided to the browser and received over the data transmission network. (Specification at 2:27, 6:7-8, 6:15-29, and Figures 2 and 4.) The server also includes a destination selection system to determine a location for storing scanning data from inputs to the browser. (Specification at 7:1-20, 7:30-33, and Figures 2 and 4.) The location is selected from locations including locations other than the computer. (Specification at 3:16-19, 7:13-20, and Figure 4.) The server further includes a delivery system that transfers the selected driver to the computer over the data transmission network. (Specification at 2:30-33, 8:15-18, 8:26-28, and Figure 2.) The selected driver is configured to enable the computer to store images captured at the location. (Specification at 8:30-9:5.) The destination selection system is further configured to insert a destination address of the selected location for storing the scanning data in a self-extracting executable file. (Specification at 8:16-26, 9:1-5, and Figure 2.) The self-extracting executable file also includes the selected driver. (Specification at 8:16-23, and Figure 2.) The server is configured to transfer the self-extracting executable file to the computer. (Specification at 2:30-33, 8:26-31, and Figures 1 and 2.)

3.   <u>Independent Claim 30</u>

Independent claim 30 is directed to a method comprising receiving information over a data transmission network from a browser hosted on a computer, wherein the browser enables a user to browse information received over the data transmission network. (Specification at 2:25-26, 3:13-20, 5:3-7, and Figures 2-5.) The method also includes enabling selection from the browser of at least one scanner driver from a

plurality of scanner drivers in response to the received information, and enabling selection from the browser of a location for storing scanning data in response to the received information. (Specification at 2:27, 6:7-29, 7:1-20, 7:30-33, and Figures 2 and 4.) The location is selected from locations including locations other than the computer. (Specification at 3:16-19, 7:13-20, and Figure 4.) The method further includes inserting the selected scanner driver in a self-extracting executable file, and inserting a destination address of the selected location for saving the scanning data in the self-extracting executable file. (Specification at 8:16-26, 9:1-5, and Figure 2.) The self-extracting executable file is then transferred to the computer. (Specification at 2:30-33, 8:26-31, and Figures 1 and 2.)

4. Independent Claim 38

Independent claim 38 is directed to a server configured to enable a user at a remote computer to scan a document at a scanner to obtain scanning data. (Specification at Abstract, 2:14-23, 3:4-6, 8:31-9:2, and Figures 1 and 2.) The server comprises means for storing multiple scanner drivers and means for enabling the user to select a driver for the scanner from the means for storing in response to one or more inputs provided to a browser hosted at the remote computer. (Specification at 2:25-30, 6:7-32, and Figures 2 and 4.) The browser enables the user to browse information received over a data transmission network, and the server receives the one or more inputs over the data transmission network. (Specification at 2:25-26, 3:13-20, 7:22-26, and Figures 1-5.) The server also includes means for enabling the user to select a location from the browser for saving the scanning data. (Specification at 7:1-20, 7:30-33, and Figures 2 and 4.) The user can select the location from multiple locations including locations other than the remote computer. (Specification at 3:16-19, 7:13-20, and Figure 4.) The server further includes means for transferring the selected driver and the selected location to the remote computer in a self-extracting file. (Specification at 2:30-33, 8:16-26, 9:1-5, and Figures 1 and 2.)

5.   <u>Independent Claim 42</u>

Independent claim 42 is directed to a computer-implemented method for scanning an original. (Specification at Abstract and 2:16-19.) The method comprises receiving at a first computer a request for authentication from a second computer coupled to a scanner, and authenticating the second computer. (Specification at 5:9-6:5 and Figure 3.) The second computer does not have a driver for the scanner. (Specification at Abstract and 3:8-14.) The method also includes determining one or more scanner drivers that may be used for scanning, providing an indication of the one or more scanner drivers to the second computer, and receiving a selection of a scanner driver from the second computer. (Specification at 2:27, 6:12-29, 7:22-24, and Figures 2 and 4.) At least one of the scanner drivers may be used by the second computer to communicate with the scanner. (Specification at 8:31.) The method further includes receiving a selection of a location for storing scanning data from the second computer. (Specification at 7:1-20, 7:30-33, and Figure 2.) The location is selected from locations including locations other than the second computer. (Specification at 3:16-19, 7:13-20, and Figure 4.) Additionally, the method includes transferring the selected scanner driver in a self-extracting file to the second computer. (Specification at 2:30-33, 8:16-23, 8:26-28, and Figures 1 and 2.) The selected location is also included in the self-extracting file. (Specification at 8:24-26 and Figure 2.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. The Examiner's Rejections

The Examiner's rejections in the Final Office Action are as follows:

1. Claims 3, 4, 10-11, 13, 14, 19-23, 25, 28, 30, 32-35, and 38-40 were rejected under 35 U.S.C. § 103(a) over the combination of U.S. Patent No. 6,594,690 to Cantwell ("Cantwell") and U.S. Patent No. 6,459,499 to Tomat ("Tomat").

2. Claims 5-8, 15, 16, 18, and 37 were rejected under 35 U.S.C. § 103(a) over the combination of Cantwell, Tomat, and U.S. Patent No. 6,785,805 to House et al. ("House").

3. Claim 24 was rejected under 35 U.S.C. § 103(a) over the combination of Cantwell, Tomat, and U.S. Patent No. 5,587,533 to Schneider et al. ("Schneider").

4. Claims 42-45 were rejected under 35 U.S.C. § 103(a) over the combination of U.S. Patent No. 7,120,910 to Matsuda et al. ("Matsuda"), Cantwell, and Tomat.

B. The Issues on Appeal

1. Whether the Examiner erred in rejecting claims 3, 4, 10, 11, 13-14, 19-23, 25, 28, 30, 32-35, and 38-40 under 35 U.S.C. § 103(a) over the combination of Cantwell and Tomat where:

> (a) the Examiner failed to show that the applied references, either alone or in combination, disclose or suggest all the claimed features;

> (b) the applied references teach away from the claim elements;

(c) modifying the applied references according to the features of the claims would be a substantial reconstruction and redesign of these references that produces a nonsensical result; and

(d) the Examiner failed to articulate a rational apparent reason to combine the references?

2. Whether the Examiner erred in rejecting claims 5-8, 15, 16, 18, and 37 under 35 U.S.C. § 103(a) over the combination of Cantwell, Tomat, and House?

3. Whether the Examiner erred in rejecting claim 24 under 35 U.S.C. § 103(a) over the combination of Cantwell, Tomat, and Schneider?

4. Whether the Examiner erred in rejecting claims 42-45 under 35 U.S.C. § 103(a) over the combination of Matsuda, Cantwell, and Tomat?

VII. ARGUMENT

As explained in detail below, the Examiner's rejections contain significant legal errors and, accordingly, the Examiner's rejections should be reversed. The impropriety of the Examiner's rejections of the pending claims is based on the Examiner's failure to meet the following requirements.

A. Legal Standards for Obviousness

All the pending claims stand rejected as being obvious under 35 U.S.C. § 103(a), which provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The Examiner has the initial burden of factually supporting any prima facie conclusion of obviousness under 35 U.S.C. § 103(a). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). For example, the *Graham* Court stated:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

More recently, in the *KSR* case the Supreme Court reaffirmed the holdings of *Graham* and clarified several aspects of the manner in which obviousness should be determined (*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007)). To present a *prima facie* case of obviousness, the Examiner must show that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." (*KSR*, 550 U.S. at 418.) Relevant considerations may include "interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art." (*Id.*) However, "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." (*Id.*). In presenting an obviousness rejection, the Examiner's analysis "should be made explicit." (*Id.*) "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal standard of obviousness." (*Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).) Moreover, the Court recognized that many significant advances will combine familiar elements: "inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (*Id.*)

Following the Supreme Court decision in *KSR*, the United States Patent and Trademark Office ("USPTO") issued a memorandum to all Examiners. The memorandum directs Examiners to continue to determine why a person of ordinary skill

in the art would make the combination: "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." (USPTO Memorandum, Supreme Court decision on *KSR Int'l. Co. v. Teleflex, Inc.*, May 3, 2007, p. 2.)

Furthermore, references cannot be combined where references teach away from their combination since it is improper to combine references where the references teach away from their combination. (*In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).)

Under the foregoing legal standards, Appellant's invention is not obvious. For at least the reasons explained below, the Examiner has failed to satisfy his burden of presenting a *prima facie* case of obviousness. For example, the Examiner has not identified references that disclose or suggest all the elements of the pending claims. Furthermore, the applied references teach away from the claim elements and modifying the applied references according to the features of the claims would be a substantial reconstruction and redesign of these references that produces a nonsensical result. Therefore, the rejections of these claims under 35 U.S.C. § 103(a) should be reversed.

B.   Overview of the Applied References

The Examiner rejected the claims based on the following references:

1.   U.S. Patent No. 6,594,690 (Cantwell)

Cantwell describes executable code that can download and install a device driver. (Cantwell at 1:34-44.) Referring to Figure 2 of Cantwell, this reference discloses that a user can use a browser to browse to a driver website, where the browser downloads and then executes executable code. (Cantwell at 2:20-22 and 2:45-47.) The executable code installs any required software on the user's client, such as client-to-device communication software. (Cantwell at 2:47-50.) The executable code then spawns a setup and configuration utility on the client, and information about the device (e.g., model number) is communicated to the executable code. (Cantwell at 2: 54-60.)

The executable code uses this information to select a driver for the device. (Cantwell at 3:3-7.) Once a driver is selected, the executable code downloads from the driver website and installs the selected driver on the client. (Cantwell at 3:8-10.)

2.   U.S. Patent No. 6,459,499 (Tomat)

Tomat is directed to a system for scanning documents that automatically determines how to scan and send a resulting image file based on a predefined profile. (Tomat at 3:22-24.) Referring to Figure 7 of Tomat, this reference discloses an add/edit window 130 allows a user to specify a temporary file location 140 and other aspects of an image file in block 133 as part of the user's profile. (Tomat at 9: 48-59 and 10:12-25.) A collection of user profiles 50 are stored as text or in an encoded form on a fixed disk 15 of a computer system 2 to which the scanner 1 is attached. (Tomat at 9:6-9; *see also* Tomat, Figure 2.) Alternately, the user profiles 50 are stored on a network disk 83 attached to a server 68. (Tomat at 9:15-20.)

Tomat discloses that an autosend utility can receive a remote recipient's identity and find the corresponding profile. (Tomat at 2:48-50.) A scanner can then scan a document according to the scanning characteristics for that profile, and the autosend utility can send a temporary image file containing image data from the scanned document to the remote recipient using the profile's transport information. (Tomat at 2:51-56.)

3.   U.S. Patent No. 6,785,805 (House)

House is directed to network-based methods and systems for a built-to-order internet application that requires a user to log-in or register to gain access to a website server. (House at 29:14-19.)

4.   U.S. Patent No. 5,587,533 (Schneider)

Schneider discloses an ultrasonic system and method for imaging a surface with a C-scan for use with fingerprint imaging. (Schneider at Abstract.) A main driving

routine can query a user whether to save scanned data and under what file name. (Schneider at 23:40-42.)

5.   U.S. Patent No. 7,120,910 (Matsuda)

Matsuda is directed to a web server function for an imaging processing apparatus that generates a list of information regarding the status of various jobs and image data and stores the list in a web page. (Matsuda at Abstract.) A user can set a password on the web page to display a box including such a list. (Matsuda at 13:59-67.)

C.   Discussion of the Examiner's Improper Rejections

For at least the reasons explained below, the Examiner improperly rejected the pending claims and these rejections should be reversed.

1.   The Section 103(a) Rejection of Claims 3, 4, 10, 11, 13, 14, 19-23, 25, 28, 30, 32-35, and 38-40 over the Combination of Cantwell and Tomat is Improper and Should be Reversed

Claims 3, 4, 10, 11, 13-14, 19-23, 25, 28, 30, 32-35, and 38-40 stand rejected under 35 U.S.C. § 103(a) over the combination of Cantwell and Tomat. As set forth in detail below, the Examiner failed to establish a *prima facie* case for rejecting claims 3, 4, 10, 11, 13, 14, 19-23, 25, 28, 30, 32-35, and 38-40 under Section 103 over these references for at least the following reasons: (i) the Examiner failed to show that the applied references, either alone or in combination, disclose or suggest all the claim elements; (ii) the applied references teach away from the claim elements; (iii) modifying the applied references according to the features of the claims would be a substantial reconstruction and redesign of these references that produces a nonsensical result; and (iv) the Examiner failed to articulate a rational apparent reason to combine the references.

a.   Claim 25

i.   The Examiner has Failed to Show that the Applied
References Disclose or Suggest All of the Elements
of Claim 25, and has Thereby Failed to Establish a
Prima Facie Case of Obviousness

Independent claim 25 is patentable under Section 103 over the combination of Cantwell and Tomat because the Examiner has failed to show that the applied references, either alone or in combination, disclose or suggest all the features of independent claim 25. More specifically, the applied references fail to disclose or suggest, *inter alia*, a server for a network comprising:

> a destination selection system configured to enable the user to select a location from the browser for saving the scanning data…and further configured to insert a destination address of the selected location for saving the scanning data in a self-extracting executable file, the self-extracting executable file also including the selected driver, wherein the server is configured to transfer the self-extracting executable file to the computer.

(1)   Cantwell Fails to Disclose or Suggest Several
Features of Claim 25

As provided above, independent claim 25 is directed to a server for a network comprising, *inter alia*, a "self-extracting executable file also <u>including the selected driver, wherein the server is configured to transfer the self-extracting executable file to the computer.</u>" The Examiner incorrectly relies on Cantwell to disclose these features. (Final Office Action, pp. 4 and 5.) Cantwell does not disclose a server that transfers a <u>self-extracting executable file including a selected driver</u>, nor does Cantwell even disclose a <u>self-extracting executable file</u>.

In contrast to the self-extracting executable code of claim 25, Cantwell downloads executable code to a computer that, when executed, <u>selects and downloads a driver</u>. (Cantwell at 2:45-50.) Cantwell discloses, for example, that a user's browser browses to a driver website and downloads executable code. (Cantwell at 2:20-27.) When the code is executed, the code queries the user or a scanner for more information

(e.g., model) about the scanner, and uses this information to select a driver for the scanner. (Cantwell at 2:65-3:4.) Only then is the driver downloaded from the driver website to the computer. (Cantwell at 3:8-10.) Thus, Cantwell transfers executable code that <u>selects and downloads a driver</u> to a computer, whereas the self-extracting executable file of claim 25 transfers the <u>driver itself</u> to the computer. Therefore, contrary to the Examiner's assertions, Cantwell fails to disclose or suggest a "self-extracting executable file also <u>including the selected driver</u>, wherein the server is configured to transfer the self-extracting executable file to the computer," as recited in claim 25. Accordingly, for at least this reason, the Examiner failed to establish a *prima facie* case of obviousness, and the Section 103 rejection should be reversed.

The Examiner also incorrectly correlates Cantwell's executable code to the self-extracting executable file of claim 25. For example, the Examiner suggests that "since the browser downloads and then executes executable code. Thus the executable code executed by browser. Another words [sic], this executable code is self-extracting by means of browser." (Final Office Action, pg. 5.) Contrary to the Examiner's apparent assertion, merely executing a code does not automatically make a file self-extracting; rather, a self-extracting file has a particular meaning to those skilled in the art. A self-extracting file is "a program file that contains one or more compressed text or data files" and running the program file "uncompresses the compressed files and stores them on the...hard drive." (<u>Microsoft Computer Dictionary</u> 471 (5th ed. 2002).) Nowhere does Cantwell disclose these features or anything related to a self-extracting file. Moreover, as discussed above, Cantwell's executable code does not even include a driver to extract. Therefore, Cantwell's executable code does <u>not</u> constitute the self-extracting executable file of claim 25. Accordingly, for at least this additional reason, the Examiner failed to establish a *prima facie* case of obviousness, and the Section 103 rejection should be reversed.

Furthermore, the Examiner conceded that Cantwell fails to disclose or suggest several features of claim 25, including:

> a destination selection system configured to enable the user to select a location from the browser for saving the scanning data, the location being selected from locations including locations other than the computer; and

further configured to insert a destination address of the selected location for saving the scanning data in a self-extracting executable file, the self-extracting executable file also including the selected driver, wherein the server is configured to transfer the self-extracting executable file to the computer.

(Final Office Action, pp. 2 and 5.)   Appellant agrees.   To cure the deficiencies of Cantwell, however, the Examiner incorrectly relies on Tomat for disclosing these features.

> (2)   <u>Tomat Fails to Disclose or Suggest the Features for Which Tomat is Cited and Accordingly Fails to Cure the Above-Noted Deficiencies of Cantwell</u>

The Examiner erroneously relies on Tomat for disclosing features of claim 25 relating to a destination selection system that is, *inter alia*, "configured to <u>insert a destination address</u> of the selected location for saving the scanning data <u>in a self-extracting executable file</u>."   (Final Office Action at pp. 2 and 3; emphasis added.) Referring to Figure 7 of Tomat, an add/edit user profile window 130 allows a user to enter a temporary file location 140 for sending scanned image data.   (Tomat at 9:48-59.) The user profiles are stored either as <u>text or in encoded form</u> on a fixed disk of a computer system or on a network disk attached to a server.   (Tomat at 9:6-9.) The Examiner erroneously argues that "since the destination address is in user profile and user profile can be located centrally on network so that users can access [the user profile] remotely . . . user can access user profile and be able to extract the destination address." (Final Office Action at pp. 3 and 6.) As discussed above, however, a person skilled in the art will appreciate that a self-extracting file is "a program file that contains one or more compressed text or data files" and running the program file "uncompresses the compressed files and stores them on the . . . hard drive."   (<u>Microsoft Computer Dictionary</u> 471 (5th ed. 2002).) Nowhere does Tomat disclose or suggest the user profiles are stored in a self-extractable file and, despite the Examiner's contention, storing a user profile in a remote location <u>does not automatically convert</u> the user profile to a self-extracting file. To the contrary, Tomat's user profile is still stored either as text or in encoded form. Accordingly, Tomat fails to disclose or suggest the features for

which it is cited. Consequently, Tomat fails to cure the above-noted deficiencies of Cantwell to support a *prima facie* Section 103 rejection of claim 25. Accordingly, for at least the foregoing reasons, the Section 103 rejection of claim 25 should be reversed.

> ii.   The Examiner has Failed to Establish a *Prima Facie* Case of Obviousness Because the Applied References Teach Away from the Features of Claim 25

The Examiner has failed to establish a *prima facie* case of obviousness in rejecting claim 25 over Cantwell and Tomat for at least the additional reason that one of ordinary skill in the art would not be motivated to modify Cantwell according to the features of claim 25 because Cantwell teaches away from such modifications. A prior art reference must be considered in its entirety, *i.e.,* as a whole, including portions that would lead away from the claimed invention. (*W.L. Gore & Associates, Inc. v. Garlock, Inc.,* 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied,* 469 U.S. 851 (1984).)

In the present case, one of ordinary skill in the art would not modify Cantwell to include the features of claim 25. As provided above, Cantwell discloses that a browser downloads executable code, and either the browser or the user provides the executable code information about a scanner. (Cantwell at 1:37-39.) The executable code then builds a list of available drivers for the scanner from the drivers stored at a driver website, and "selects a driver from the list . . . downloads the selected driver . . . then installs the selected driver." (Cantwell at 1:39-44; emphasis added.) Indeed, selecting and downloading a suitable driver is the central purpose of Cantwell's invention. It follows, therefore, that modifying Cantwell's executable code to include a driver would obviate the purpose of Cantwell's invention. Accordingly, claim 25 is further patentable over the combination of Cantwell and Tomat because Cantwell teaches away from the features of claim 25. For at least this additional reason, the Section 103 rejection should be reversed.

iii.   Modifying the Applied References According to the
        Features of Claim 25 Would be a Substantial
        Reconstruction and Redesign of these References
        that Produces a Nonsensical Result

The Examiner has failed to establish a *prima facie* case of obviousness in rejecting claim 25 over Cantwell and Tomat for at least the additional reason that the Examiner's proposed modification would change the principle of operation of Cantwell and produce a nonsensical result. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).)

As discussed above, the principle operation of Cantwell is to use executable code to select a driver and download the selected driver. Accordingly, modifying Cantwell to include a driver in the executable code or otherwise modifying Cantwell according to the features of claim 25 would change Cantwell's principle operation. For example, such modifications would eliminate the need for Cantwell's ability to install software to communicate with a scanner and query the scanner regarding its model number, thus changing how Cantwell operates. Indeed, as discussed above, including a selected driver in Cantwell's executable code would eliminate the need for Cantwell altogether because the driver has already been selected. Therefore, for at least this additional reason, the applied references fail to render claim 25 *prima facie* obvious over the applied references, and the Section 103 rejection of claim 25 should be reversed.

iv.   The Examiner has Failed to Show that There is an
       Apparent Rational Reason to Combine the
       References, and has Thereby Failed to Establish a
       Prima Facie Case of Obviousness of Claim 25

The Examiner has further erred by not articulating an apparent reason or motivation to combine Cantwell and Tomat to arrive at claim 25. To support a proper Section 103 rejection, the Supreme Court indicated that the Examiner should show that:

there was an <u>apparent reason</u> to combine the known elements in the fashion claimed by the patent at issue . . . [and that] rejections on obviousness grounds <u>cannot be sustained by mere conclusory statements</u>; instead, there must be some <u>articulated reasoning</u> with some rational underpinning to support the legal standard of obviousness.

(*KSR*, 550 U.S. at 418, underlining and bracketed information added.) More recently, on September 1, 2010, the USPTO has explicitly directed Examiners to:

provide a reasoned explanation as to why the invention as claimed would have been obvious to a person of ordinary skill in the art at the time of the invention. This requirement for explanation remains even in situations in which Office Personnel may properly rely on intangible realities such as common sense and ordinary ingenuity.

(Examination Guidelines Update: Development in the Obviousness Inquiry After *KSR v. Teleflex*, 75 Fed. Reg. 53643, 53645 (Sept. 1, 2010).)

In the present case, the Examiner has not articulated an apparent reason how or why a person of ordinary skill in the art would have combined and modified Cantwell and Tomat to arrive at the features of claim 25. Instead, the Examiner merely alleges that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Cantwell by the teachings of Tomat to conveniently access or retrieve information from browser." (Final Office Action, p. 7.) Such conclusory opinions, however, do not satisfy the articulated reasoning required by case law and recent USPTO directives.

For example, it is unclear to the Appellants how or why one of ordinary skill in the art would combine Cantwell's executable code with Tomat's user profiles to attain the features of claim 25. The Examiner's proposed combination of references still fails to disclose or suggest transferring a selected driver and a destination address in a self-extractable executable file. Tomat's alleged ability to "conveniently access or retrieve information from browser" does not cure this deficiency. Additionally, as discussed above, the references teach away from modifying the references as proposed by the Examiner in the Final Office Action. (*In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983) (improper to combine references where the references teach away from their

combination).)   Moreover, as discussed above, modifying Cantwell to include the features of claim 25 would require a substantial reconstruction of Cantwell's executable code, and redesign of Cantwell would produce a nonsensical result (e.g., it would obviate the purpose of Cantwell).   Because the Examiner does not set forth a rational apparent reason to combine the applied references, the Office Action fails to establish a *prima facie* case of obviousness.   Accordingly, for at least this additional reason, the Section 103 rejection of claim 25 should be reversed.

b.   Claims 3, 4, 10, 11, 21, 32, and 33

Claims 3, 4, 10, 11, 21, 32, and 33 depend from base claim 25. As discussed above, the Section 103 rejection of independent claim 25 should be reversed and claim 25 should be allowed. Accordingly, claims 3, 4, 10, 11, 21, 32, and 33 are also allowable as depending from independent claim 25, and also for the additional features of these dependent claims. Therefore, the Section 103 rejection of claims 3, 4, 10, 11, 21, 32, and 33 should be reversed.

c.   Claims 13, 14, 22, 23, and 28

Independent claim 28 includes several features generally similar to the features of claim 25 discussed above. For example, claim 28 recites, *inter alia*, "the destination selection system is . . . configured to insert a destination address of the selected location for storing the scanning data in a self-extracting executable file, the self-extracting executable file also including the selected driver, and wherein the server is configured to transfer the self-extracting executable file to the computer." Claim 28 is accordingly patentable over the combination of Cantwell and Tomat for at least the reasons discussed above with reference to claim 25, and for the additional features of this independent claim. Therefore, the Section 103 rejection of claim 28 over Cantwell and Tomat should be reversed.

Claims 13, 14, 22, and 23 depend from base claim 28. As discussed above, the Section 103 rejection of independent claim 28 should be reversed and claim 28 should be allowed. Accordingly, claims 13, 14, 22, and 23 are also allowable as depending from independent claim 28, and also because of the additional features of these

dependent claims. Therefore, the Section 103 rejection of claims 13, 14, 22, and 23 should be reversed.

d.   Claims 19, 20, 30, 34, and 35

Independent claim 30 includes several features generally similar to the features of claim 25 discussed above. For example, claim 30 recites, *inter alia*, "inserting the selected scanner driver in a self-extracting executable file; inserting a destination address of the selected location for saving the scanning data in the self-extracting executable file; and transferring the self-extracting executable file to the computer." Claim 30 is accordingly patentable over the combination of Cantwell and Tomat for at least the reasons discussed above with reference to claim 25, and for the additional features of this independent claim. Therefore, the Section 103 rejection of claim 30 over Cantwell and Tomat should be reversed.

Claims 19, 20, 34, and 35 depend from base claim 30. As discussed above, the Section 103 rejection of independent claim 30 should be reversed and claim 30 should be allowed. Accordingly, claims 19, 20, 34, and 35 are also allowable as depending from independent claim 30, and also because of the additional features of these dependent claims. Therefore, the Section 103 rejection of claims 19, 20, 34, and 35 should be reversed.

e.   Claims 37-40

Independent claim 38 includes several features generally similar to the features of claim 25 discussed above. For example, claim 38 recites, *inter alia*, "means for transferring the selected driver to the remote computer in a self-extracting file, wherein the self-extracting file further includes the selected location." Claim 38 is accordingly patentable over the combination of Cantwell and Tomat for at least the reasons discussed above with reference to claim 25, and for the additional features of this independent claim. Therefore, the Section 103 rejection of claim 38 over Cantwell and Tomat should be reversed.

Claims 37, 39, and 40 depend from base claim 38. As discussed above, the Section 103 rejection of independent claim 38 should be reversed and claim 38 should be allowed. Accordingly, claims 37, 39, and 40 are also allowable as depending from independent claim 38, and also because of the additional features of these dependent claims. Therefore, the Section 103 rejection of claims 37, 39, and 40 should be reversed.

　　　　2.　　　The Section 103(a) Rejection of Claims 5-8, 15, 16, 18, and 37 over the Combination of Cantwell, Tomat, and House is Improper and Should be Reversed

Claims 5-8 depend from base claim 25, claims 15 and 16 depend from base claim 28, claim 18 depends from base claim 30, and claim 37 depends from base claim 38. As discussed above, the Examiner failed to establish a *prima facie* Section 103 rejection of base claims 25, 28, 30, and 38 over Cantwell and Tomat. The Examiner relied on House for disclosing "a login system adapted to enable said user to access said driver selection system following establishing an identity of the user." (Final Office Action, pp. 9 and 10.) Without conceding that House provides the teaching for which it was cited, House nevertheless fails to cure the above-noted deficiencies of Cantwell and Tomat to support a Section 103 rejection of base claims 25, 28, 30, and 38. Accordingly, dependent claims 5-8, 15, 16, 18, and 37 are allowable over the combination of Cantwell, Tomat, and House for at least the reason that these references, either alone or in combination, fail to disclose or suggest all of the features of base claims 25, 28, 30, and 38, and for the additional features of these dependent claims. Therefore, the Section 103 rejection of dependent claims 5-8, 15, 16, 18, and 37 should be reversed and claims 5-8, 15, 16, 18, and 37 should be allowed.

　　　　3.　　　The Section 103(a) Rejection of Claim 24 over the Combination of Cantwell, Tomat, and Schneider is Improper and Should be Reversed

Claim 24 depends from base claim 25. As discussed above, the Examiner failed to establish a *prima facie* Section 103 rejection of base claim 25 over Cantwell and Tomat. The Examiner relied on Schneider for disclosing "scanned data that is stored

under a user defined file name and the user is queried if the scanned data is to be saved or not." (Final Office Action, p. 11.) Without conceding that Schneider provides the teaching for which it was cited, Schneider nevertheless fails to cure the above-noted deficiencies of Cantwell and Tomat to support a Section 103 rejection of base claim 25. Accordingly, dependent claim 24 is allowable over the combination of Cantwell, Tomat, and Schneider for at least the reason that these references, either alone or in combination, fail to disclose or suggest all of the features of base claim 25 and for the additional features of this dependent claim. Therefore, the Section 103 rejection of dependent claim 24 should be reversed and the claim should be allowed.

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4.   The Section 103(a) Rejection of Claims 42-45 over the
Combination of Matsuda, Cantwell, and Tomat is Improper and
Should be Reversed

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Claims 42-45 stand rejected under 35 U.S.C. § 103(a) over the combination of Matsuda, Cantwell, and Tomat. Independent claim 42 includes several features generally similar to the features of claim 25 discussed above. For example, claim 42 recites, *inter alia*, "transferring the selected scanner driver to the second computer includes transferring the selected scanner driver in a self-extracting file to the second computer, and wherein the selected location is also included in the self-extracting file." As described above with reference to claim 25, the Examiner erroneously relied on Cantwell for disclosing similar features. (Final Office Action, pp. 13 and 14.) The Examiner relied on Matsuda for disclosing a computer implemented method that requests authentication. (Final Office Action, p. 11.) Without conceding that Matsuda provides the teaching for which it was cited, Matsuda nevertheless fails to cure the above-noted deficiencies of Cantwell and Tomat to support a Section 103 rejection of claim 42. Claim 42 is accordingly patentable over the combination of Matsuda, Cantwell, and Tomat for at least the reasons discussed above with reference to claim 25, and for the additional features of this independent claim. Therefore, the Section 103 rejection of claim 42 over Matsuda, Cantwell, and Tomat should be reversed and the claim should be allowed.
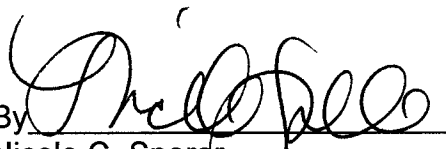
Claims 43-45 depend from base claim 42. As discussed above, the Section 103 rejection of independent claim 42 should be reversed and claim 42 should be allowed. Accordingly, claims 43-45 are also allowable as depending from independent claim 42, and also because of the additional features of these dependent claims. Therefore, the Section 103 rejection of claims 43-45 should be reversed.

VIII. CONCLUSION

As discussed in detail above, the Examiner has failed to establish a *prima facie* case of obviousness for any of the claims on appeal for at least four reasons. First, the applied references, either alone or in combination fail to teach or suggest all the claimed features. Second, the applied references teach away from the claimed features. Third, modifying the applied references according to the features of the claims would be a substantial reconstruction and redesign of these references that produces a nonsensical result. Fourth, the Examiner failed to articulate a rational apparent reason to combine the references. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejections of claims 3-8, 10, 11, 13-16, 18-25, 28, 30, 32-35, 27-40, and 42-45 and confirm the patentability of these claims. Please charge any deficiency in fees or credit any overpayments to our Deposit Account No. 50-0665, under Order No. 320528167US from which the undersigned is authorized to draw.

Dated: October 20, 2010   Respectfully submitted,

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CLAIMS APPENDIX

Claims Involved in the Appeal of Application Serial No. 09/828,856

1.   (Canceled)

2.   (Canceled)

3.   The server of claim 25 wherein the location comprises a universal resource locator (URL).

4.   The server of claim 25 wherein the location specifies one or more media to be used to save the scanning data.

5.   The server of claim 25 further comprising a login system configured to enable the user to access the driver selection system following establishing an identity of the user.

6.   The server of claim 5 wherein the login system is configured to correlate the identity of the user with an account on the server, and wherein the scanning data is saved in association with the account.

7.   The server of claim 6 wherein the account comprises an e-mail account.

8.   The server of claim 6 further comprising a viewing system for enabling the user to view the scanning data saved in association with the account.

9.   (Canceled)

10.   The server of claim 25 wherein the driver is configured to be removed from the computer after the scanning data is saved in the location.

11.   The server of claim 25, further comprising:

a delivery system to transfer the selected driver to the computer; and

a network connection configured to transmit information between the data
      transmission network and at least one of the driver selection system or the
      delivery system.

12.   (Canceled)

13.   The system of claim 28, wherein the server is configured to populate a
menu viewable at the computer on the browser identifying two or more of the plurality of
scanner drivers.

14.   The system of claim 28, wherein the server is configured to render the
menu according to a hypertext transfer protocol.

15.   The system of claim 28, wherein the server further comprises a login
system that enables the computer to access the driver selection system in response to
authentication of the user.

16.   The system of claim 15, wherein the server is configured to send one or
more cookies for storage on the computer in response to the authentication.

17.   (Canceled)

18.   The method of claim 30, further comprising:

authenticating a user at the computer in response to information received at the
      browser; and

enabling the selection of the at least one scanner driver in response to the
      authenticating the user.

19.   The method of claim 30, wherein the receiving the information over the data transmission network comprises receiving the information according to a hypertext transfer protocol.

20.   The method of claim 30, wherein the enabling selection of at least one scanner driver in response to the received information comprises receiving inputs from a menu rendered on the browser.

21.   The server of claim 25, wherein the location comprises an electronic mail (e-mail) account address.

22.   The system of claim 28, wherein the location comprises a universal resource locator (URL).

23.   The system of claim 28, wherein the location comprises an electronic mail (e-mail) account address.

24.   The server of claim 25, wherein the destination selection system is further configured to:
        determine whether the user has write permission associated with the location; and
        warn the user if the location is not a valid destination for storing the scanning data.

25.   A server for a network, the server configured to enable a user at a computer to scan a document at a scanner to obtain scanning data, the server comprising:
        a database of scanner drivers;
        a driver selection system configured to enable the user to select a driver for the scanner from the database of scanner drivers in response to one or more inputs provided to a browser hosted at the computer, wherein the browser

enables the user to browse information received over a data transmission network, and wherein the one or more inputs are received at the server over the data transmission network; and

a destination selection system configured to enable the user to select a location from the browser for saving the scanning data, the location being selected from locations including locations other than the computer; and further configured to insert a destination address of the selected location for saving the scanning data in a self-extracting executable file, the self-extracting executable file also including the selected driver,

wherein the server is configured to transfer the self-extracting executable file to the computer.

26.   (Canceled)

27.   (Canceled)

28.   A system comprising:

a scanning station comprising a computer connected to a data transmission network, the computer including a browser that enables a user to browse information received over the data transmission network, and a scanner in communication with the computer; and

a server comprising:

    a plurality of scanner drivers;

    a driver selection system to select one of the plurality of scanner drivers in response to one or more inputs provided to the browser and received over the data transmission network;

    a destination selection system to determine a location for storing scanning data from inputs to the browser, the location being selected from locations including locations other than the computer; and

    a delivery system to transfer the selected driver to the computer over the data transmission network,

wherein the selected driver is configured to enable the computer to store images captured at the location,

wherein the destination selection system is further configured to insert a destination address of the selected location for storing the scanning data in a self-extracting executable file, the self-extracting executable file also including the selected driver, and

wherein the server is configured to transfer the self-extracting executable file to the computer.

29.   (Canceled)

30.   A method comprising:

receiving information over a data transmission network from a browser hosted on a computer, wherein the browser enables a user to browse information received over the data transmission network;

enabling selection from the browser of at least one scanner driver from a plurality of scanner drivers in response to the received information;

enabling selection from the browser of a location for storing scanning data in response to the received information, the location being selected from locations including locations other than the computer;

inserting the selected scanner driver in a self-extracting executable file;

inserting a destination address of the selected location for saving the scanning data in the self-extracting executable file; and

transferring the self-extracting executable file to the computer.

31.   (Canceled)

32.   The server of claim 25 wherein the selected driver is transferred to the computer over a file transfer protocol connection.

33.   The server of claim 25 wherein the destination selection system enables the user to select a location from the browser by indicating the location in a text box provided by the browser.

34.   The method of claim 30 wherein the selected scanner driver is transmitted to the computer over a file transfer protocol connection.

35.   The method of claim 30 wherein enabling selection of a location includes enabling selection of a location indicated in a text box provided by the browser.

36.   (Canceled)

37.   The server of claim 38, further comprising means for authenticating the user.

38.   A server configured to enable a user at a remote computer to scan a document at a scanner to obtain scanning data, the server comprising:

   means for storing multiple scanner drivers;

   means for enabling the user to select a driver for the scanner from the means for storing in response to one or more inputs provided to a browser hosted at the remote computer, wherein the browser enables the user to browse information received over a data transmission network, and wherein the server receives the one or more inputs over the data transmission network;

   means for enabling the user to select a location from the browser for saving the scanning data, wherein the user selects the location from multiple locations including locations other than the remote computer; and

   means for transferring the selected driver to the remote computer in a self-extracting file, wherein the self-extracting file further includes the selected location.

39.   The server of claim 38, further comprising means for storing scanning data of the user.

40.   The server of claim 39, further comprising means for enabling the user to view the stored scanning data.

41.   (Canceled)

42.   A computer-implemented method for scanning an original, the method comprising:

receiving at a first computer a request for authentication from a second computer coupled to a scanner, wherein the second computer does not have a driver for the scanner;

authenticating the second computer;

determining one or more scanner drivers that may be used for scanning, wherein at least one of the scanner drivers may be used by the second computer to communicate with the scanner;

providing an indication of the one or more scanner drivers to the second computer;

receiving a selection of a scanner driver from the second computer;

receiving a selection of a location for storing scanning data from the second computer, wherein the location is selected from locations including locations other than the second computer; and

transferring the selected scanner driver to the second computer,

wherein transferring the selected scanner driver to the second computer includes transferring the selected scanner driver in a self-extracting file to the second computer, and

wherein the selected location is also included in the self-extracting file.

43.   The computer-implemented method of claim 42 wherein receiving a selection of a location for storing scanning data from the second computer includes

receiving a selection of a location to which the first computer is coupled, and wherein the method further comprises:

receiving a request to view stored scanning data from the second computer;

accessing the location to which the first computer is coupled;

retrieving the stored scanning data; and

transferring the stored scanning data to the second computer.

44.   The computer-implemented method of claim 42, further comprising:

determining whether the second computer has permissions necessary to store scanning data at the location; and

sending a warning to the second computer if the second computer does not have permissions necessary to store scanning data at the location.

45.   The computer-implemented method of claim 42 wherein the location is selected from at least one of a storage medium, an email address and a Uniform Resource Locator (URL).

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.